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10/771,809

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Hank Risan

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EXAMINER

MORAN, RANDAL D

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/771,809	Applicant(s) RISAN ET AL.	
	Examiner RANDAL D. MORAN	Art Unit 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the communication filed 12/5/2008.

Claims 1-44 are pending.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5, 14, 16, 21, 31, 37, 43 and 44 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, 12, 13, 15, 17, 19 and 22 of copending Application No. 10/772025. Although the conflicting claims are not identical, they are not patentably distinct from each other because 10/772025 is directed towards a method of preventing unauthorized recording of electronic media by activating a compliance mechanism, controlling a data path and directing media content to customer device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant states in Remarks filed 12/05/2008 that a terminal disclaimer was being submitted with that response. It has not been received by the office, therefore the Double Patenting rejection stands until it is received.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-44 are rejected under 35 U.S.C. 102(e) as being anticipated by **Doherty et al. (6,920,567)**, hereafter ‘Doherty’.

Considering **Claim 1**, Doherty discloses: installing a compliance mechanism on a computer system, said compliance mechanism communicatively coupled with said computer system when installed thereon, said compliance mechanism for enforcing compliance with a usage restriction applicable to said media (Column 4, Lines 15-34); obtaining control of a data pathway operable on said computer system (Column 4, Lines 15-34); accessing data disposed on said media storage device to determine said usage restriction (Column 4, Lines 15-34, Column 5, Lines 46-67); and selectively preventing

said computer system from digitally accessing said media via said data pathway while enabling presentation of the media (Column 4, Lines 15-34, Column 5, Lines 46-67).

Considering **Claim 16**, Doherty discloses: a compliance mechanism disposed on said media storage device and configured to be installed on and communicatively coupled with a computer system, said compliance mechanism for enforcing compliance with a usage restriction applicable to said media (Column 4, lines 15-34); a device drive coupled with said computer system for accessing said media storage device, said device drive communicatively coupled with an analog sound rendering device of said computer system (column 23, Lines 46-67); and wherein said compliance mechanism is configured to selectively prevent access to said media via a digital data pathway of said computer system while presenting said media via said analog sound rendering device (column 23, Lines 46-67).

Considering **Claim 31**, Doherty discloses: invoking an autorun protocol disposed on said media storage device in response to a device drive coupled with said computer system receiving said media storage device, said autorun protocol for installing a compliance mechanism on said computer system (Column 5, Lines 46-Column 6, Lines 6, Column 15, Lines 11-30); installing said compliance mechanism on said computer system, said compliance mechanism communicatively coupled with said computer system when installed thereon, said compliance mechanism for providing compliance with a usage restriction associated with said media (Column 4, lines 15-34); acquiring control of a digital data pathway of said computer system with a filter driver coupled with said compliance mechanism and with said computer system, said filter driver installed during said installing of said compliance mechanism (column 23, Lines

46-67); and selectively restricting said media on said media storage device from being accessed via said digital data pathway while enabling presentation of said media using an analog sound rendering device communicatively coupled with said device drive (column 23, Lines 46-67).

Considering **Claim 2**, rejected as applied to claim 1. Doherty discloses: wherein said usage restriction comprises a copyright restriction or a licensing agreement associated with said media (Column 4, Lines 15-34).

Considering **Claim 3, 17 and 22**, Doherty discloses: installing a filter driver on said computer system, said filter driver configured to be coupled with and operable in conjunction with said compliance mechanism and for controlling said data pathway (Fig. 1A and 2 Column 23, Lines 47-60).

Considering **Claim 4**, Doherty discloses: said filter driver prevents digitally accessing said media (Fig. 1A and 2 Column 23, Lines 47-60).

Considering **Claim 5, 15, 20, 24, 30, 38 and 44**, Doherty discloses: activating an autorun mechanism disposed on said media storage device in response to a device drive coupled with said computer system receiving said media storage device, said autorun mechanism for initiating said installing said compliance mechanism on said computer system (Column 5, Lines 46-Column 6, lines 6, Column 15, Lines 11-30).

Considering **Claim 6**, Doherty discloses: presenting said media using an analog sound rendering device communicatively coupled with said device drive via an analog signal path (Column 9, Lines 50-67).

Considering **Claim 7, 21 and 23**, Doherty discloses: wherein said autorun mechanism is activated in response to detection of a usage restriction indicator disposed

on said media storage device, subsequent to said device drive receiving said media storage device (Column 4, Lines 15-34 and Column 5, Lines 46-Column 6, Lines 6).

Considering **Claim 8**, Doherty discloses: wherein said autorun mechanism is activated in response to detection of a selection of an icon representing said media (Column 5, Lines 46-Column 6, lines 6, Column 15, Lines 11-30).

Considering **Claim 9 and 32**, Doherty discloses: bypassing said installing said compliance mechanism on said computer system if an instance of said compliance mechanism is predisposed on said computer system (Column 23, Lines 47-60).

Considering **Claim 10, 18, 19, 33 and 34**, Doherty discloses: initiating a communication session between said computer system and a network to which said computer system is coupled and from which said compliance mechanism is available; comparing said compliance mechanism present on said computer system and said compliance mechanism available from said network; and updating said compliance mechanism on said computer system (Column 16, Lines 58-Column 17, Lines 45).

Considering **Claim 11, 26 and 40**, Doherty discloses: deactivating said compliance mechanism upon detection of uncoupling of said media storage device from said computer system (Column 34, Lines 6-41).

Considering **Claim 12, 27 and 41**, Doherty discloses: uninstalling said compliance mechanism upon detection of uncoupling of said media storage device from said computer system (Column 4, Lines 6-41).

Considering **Claim 13, 28, and 42**, Doherty discloses: wherein said media storage device upon which said media is disposed is from a group of media storage devices consisting of a compact disk (CD), a mini CD, a digital versatile disk (DVD), a

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mini DVD, a compact flash card, a secure digital (SD) card, a memory stick, a digital audio tape (DAT), a digital video tape (DVT), a holographic storage object, a magneto-optical disk, a multi-layer fluorescent disk, an optical disk, and a magnetic disk (Fig. 1A Column 10, Lines 40-67).

Considering **Claim 14, 29 and 43**, Doherty discloses: installing a media identification mechanism on said computer system; utilizing said media identification mechanism to identify an instance of media disposed on said media storage device; determining a usage restriction applicable to said instance of media; and using said compliance mechanism to selectively control digitally accessing said instance of media based upon said determining (Column 8, lines 60- Column 9, Lines 30).

Considering **Claim 25 and 39**, Doherty discloses: wherein said usage restriction comprises copyright restriction or licensing agreement applicable to said media (Fig. 1A and 2).

Considering **Claim 35**, Doherty discloses: activating a presentation mechanism coupled with said computer system for presenting said media, said presentation mechanism authorized to present said media in accordance with said compliance mechanism (Fig. 1A).

Considering **Claim 36**, Doherty discloses: installing a presentation mechanism on said computer system to enable said computer system to present said media, said presentation mechanism authorized to present said media in accordance with said compliance mechanism (Fig. 1A).

Response to Arguments

Applicant states in Remarks filed 12/05/2008 that a terminal disclaimer was being submitted with that response. It has not been received by the office, therefore the Double Patenting rejection stands until it is received.

Applicant's arguments filed 12/5/2008 have been fully considered but they are not persuasive.

Regarding **Claims 1, 16, and 31**, applicant's arguments have been fully considered but are not persuasive. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

With respect to applicant's argument that Doherty fails to teach *obtaining control of a data pathway operable on said computer ... and selectively preventing said computer from digitally accessing said media via said pathway while enabling presentation of the media,*" applicant is directed to Doherty, column 4, lines 15-34, column 5, lines 46-67. Doherty discloses:

"The information contained in the dynamic license database and controlling licensed use of the digital content includes user accessible information defining a license available to a user and controlling use of the digital contents by the user and may include license purchase information defining the terms of purchase of at least one license available to a user. In the latter case, the license control utility

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and license monitor and control mechanism are responsive to user input through the graphical user interface for accessing the purchase information in the dynamic license database, accessing the user system to obtain system information identifying the user system in which the digital content is to be used, communicating purchase information for a license selected from the at least one license defined therein to an external system, receiving from the external system license information corresponding to the purchase information, and writing the license information into the dynamic license database for use by the license monitor and control mechanism in controlling licensed use of the digital content by the user.”

Doherty teaches accessing the user system to obtain system information identifying the user. The transmission of data to and from separate devices requires control of a data pathway.

Doherty further discloses:

“The present invention further includes a method for constructing a digital content file to be installed in a user system wherein the digital content file includes an embedded file access control mechanism for controlling the licensed use of digital content and wherein the digital content of the digital content file includes executable code. This method includes the steps of generating a reconstructed executable code by extracting from the executable code information identified as critical and necessary to the execution of the executable code and inserting links to a wrapper dynamic linked library wherein the wrapper dynamic linked library includes a control dynamic linked library containing control functions for the display and behavior of options for license purchase and generation and a main dynamic linked library including a license functions mechanism and the extracted information identified as critical and necessary to execution of the executable code. The method then includes the steps of generating an encrypted reconstructed executable code by encrypting the executable code of the reconstructed executable code and the links inserted into the reconstructed executable code, generating an encrypted wrapper dynamic linked library by encrypting the wrapper dynamic linked library, and constructing a product installer by combining the encrypted reconstructed executable code, the encrypted wrapper dynamic linked library, a dynamic license database, and a license decrypt/extraction mechanism, wherein the product installer is distributed to a user system.”

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Doherty teaches an embedded file access control mechanism (i.e. rules to prevent digital access to the media) which block access to the media while performing execution of the executable code (i.e. enabling presentation).

Regarding **Claim 6**, applicant's arguments have been fully considered but are not persuasive. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

With respect to applicant's argument that Doherty fails to teach *presenting said media using an analog sound rendering device communicatively coupled with said device drive via an analog signal path*, applicant is directed to Doherty, column 9- lines 50-67. Doherty discloses:

"In addition to computer programs and data files, the present system and embedded file access control mechanism may be used a similar manner in the delivery and control of products containing digitally formatted audio and image information, such as audio and video files, music and movies, through similar channels."

The limitation of presenting media using an analog sound rendering device is merely a recitation of the intended use of playing the media via an analog signal path, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the

claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Doherty teaches audio and video files. Audio and video files can be read to include analog signals. There are numerous examples of analog audio signal processing using a media storage device including but not limited to crossover filters in loudspeakers and volume controls on a radio or stereo.

Regarding **Claims 16 and 31**, applicant's arguments have been fully considered but are not persuasive. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

With respect to applicant's argument that Doherty fails to teach *selectively restricting said media on a media storage device from being accessed via said digital data pathway while enabling presentation of said media using an analog sound rendering device communicatively coupled with said device drive*, applicant is directed to the Response to Arguments for Claims 1, 16, and 31.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RANDAL D. MORAN whose telephone number is (571)270-1255. The examiner can normally be reached on M-F: 7:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. D. M./
Examiner, Art Unit 2435
3/1/2009
/Kimyen Vu/
Supervisory Patent Examiner, Art Unit 2435